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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,262	01/16/2004	Kevin Sullivan	JPC-011 D1	5705

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GOODWIN PROCTER LLP
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EXAMINER	
LIVERSEDGE, JENNIFER L	

ART UNIT	PAPER NUMBER
3692	

NOTIFICATION DATE	DELIVERY MODE
08/13/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/758,262	SULLIVAN, KEVIN	
	Examiner	**Art Unit**	
	JENNIFER LIVERSEDGE	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 30 May 2008.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 37,40-45 and 47-50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 37,40-45 and 47-50 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for continued examination of Application 10/758,262 filed on May 30, 2008.

The amendment contains previously presented claims: 40-43, 45 and 47-50.

The amendment contains amended claims: 37 and 44.

Claims 1-36, 38-39, 46 and 51-52 have been canceled.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 30, 2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 37, 40-45 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,070,153 to Simpson (further referred to as Simpson), in view of US Patent 6,631,358 B1 to Ogilvie (further referred to as Ogilvie), in view of US Patent 6,345,261 B1 to Feidelson et al. (further referred to as Feidelson), in view of "The new cobrand wisdom: mine your backyard" in Credit Card News (further referred to as Credit Card News), and further in view of Case Law – *in re Venner*.

Regarding claim 37, Simpson discloses a computerized method for implementation of multiple accounts, wherein the multiple accounts include at least one card payment instrument account from a card issuer and at least one investment account from a financial institution (columns 1-6), the method comprising:

Providing a card and investment application to an applicant, the card and investment applications entitling an approved cardholder to establish a card payment instrument account and an investment account (column 2, lines 32-49; column 3, line 50 – column 4, line 67);

Approving a submitted card and investment application (column 3, line 55 - column 4, line 37);

Establishing the card payment instrument account through the card issuer for the approved cardholder upon acceptance, wherein the card payment instrument account includes a reward feature available to the cardholder (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Creating the investment account for the approved cardholder through the financial institution upon approval (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Linking the card payment instrument account from the card issuer to the investment account from the financial institution (Figure 1; column 2, lines 30-41; column 4, lines 27-37; column 6, lines 19-27);

Establishing a reward structure through an agreement between the financial institution and the card issuer (column 1, lines 46-63; column 2, lines 9-11; column 5, lines 25-30);

Implementing the reward feature by tracking expenditures made through the card payment instrument account and calculating a monetary reward amount in relation to the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28);

Depositing the monetary reward amount generated by the reward feature into the investment account at a predetermined time interval (Figure 3; column 1, lines 45-63); and

Allowing independent funding of the investment account by the cardholder (Figures 1 and 3; column 1, lines 54-67; column 2, lines 17-22; column 4, lines 13-19; column 4, line 63-column 5, line 5; column 5, lines 41-59).

Simpson does not disclose an investment fund card application enabling establishment of a card and an investment account. However, Ogilvie discloses where one application is used to both apply for and establish a credit card and an investment vehicle based on the card use, wherein a single application is filled out for both the credit card and for designating a reward selection (column 1, lines 56-67). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the simultaneous accepting of credit card and investment fund account applications for the establishment of linked accounts as disclosed by Simpson to adapt the use of a single form for both accounts as disclosed by Ogilvie. The motivation would be that both accounts are set up using an individual's personal data and information, and establishing both accounts based on this one-time receipt of data enables an efficient and less error prone mechanism for opening linked accounts.

Neither Simpson nor Ogilvie disclose wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer. However, Feidelson discloses wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer (column 14, lines 38-

42). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of a credit card wherein a reward feature is implemented through partnership with another organization using a single application as disclosed by Simpson and Ogilvie to adapt issuing a credit card that bears partnership organizations on the card as disclosed by Feidelson. The motivation would be that co-branding a credit card by including the names of participating organizations on the card, rather than just one organization in the partnership, builds customer use in using the card by providing visual queues as to the benefit of the using the card. When a user is preparing to pay for a purchase and opens their wallet and sees, for example, three credit cards, the credit card with a visual reminder that using that card will result in a deposit into one's investment account based on the purchase value will inspire the purchaser to select that card for the purchase over a card which offers no specific and tangible reward. Building loyalty and encouraging use is the motivation behind the use of co-branded credit cards.

Neither Simpson nor Ogilvie nor Feidelson disclose where the funding of the reward feature is shared between the financial institution and the card issuer. However, Credit Card News discloses where the funding of the rewards is shared between the co-branding partners. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the reward system using a co-branded credit card as disclosed by the combination of Simpson, Ogilvie and Feidelson to adapt the reward sharing between co-branding partners as disclosed by Credit Card News. The motivation would be that each party is a partner in the co-branded product and therefore sharing the

burden of rewards creates in a more economically pleasing partnership and program ownership.

Neither Simpson, Ogilvie, Feidelson nor Credit Card News specifically disclose automatically creating the investment account for the approved cardholder. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have automated creating the account because it would have sped up the process of account creation particularly given that all of the data necessary for creating the investment account manually are known to each of Simpson, Ogilvie and Feidelson and the end result would have been the same as compared to the manual method. *In re Venner, 262 F.2d 91, 95, 1209 USPQ 193, 194 (CCPA 1958).*

Regarding claim 44, Simpson discloses a computerized method for establishing and implementing multiple accounts, wherein the multiple accounts include at least one card payment instrument account from a card issuer and at least one investment account from a financial institution (columns 1-6), the method comprising:

Simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution (column 2, lines 30-38; column 3 line 50-column 4, line 53; column 6, lines 19-26);

When a recipient of an offer for multiple accounts accepts the offer for multiple accounts, establishing the card payment instrument account in response to the acceptance, wherein the card payment instrument account includes a reward feature available to the recipient (Figures 1 and 3; column 1, lines 10-25 and lines 45-63;

column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Creating the investment account in response to the acceptance by notifying the financial institution to create the investment account upon issuance of the card payment instrument account by the card issuer (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Establishing a reward structure through an agreement between the financial institution and the card issuer (column 1, lines 46-63; column 2, lines 9-11; column 5, lines 25-30);

Implementing the reward feature by tracking expenditures made through the card payment instrument account and calculating a monetary reward amount in relation to the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28); and

Depositing the monetary reward amount generated by the reward feature into the investment account at predetermined time intervals (Figure 3; column 1, lines 45-63).

Simpson does not disclose an investment fund card application enabling establishment of a card and an investment account. However, Ogilvie discloses where one application is used to both apply for and establish a credit card and an investment vehicle based on the card use, wherein a single application is filled out for both the credit card and for designating a reward selection (column 1, lines 56-67). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the simultaneous accepting of credit card and investment fund account applications for the

establishment of linked accounts as disclosed by Simpson to adapt the use of a single form for both accounts as disclosed by Ogilvie. The motivation would be that both accounts are set up using an individual's personal data and information, and establishing both accounts based on this one-time receipt of data enables an efficient and less error prone mechanism for opening linked accounts.

Neither Simpson nor Ogilvie disclose wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer. However, Feidelson discloses wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer (column 14, lines 38-42). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of a credit card wherein a reward feature is implemented through partnership with another organization through a single application as disclosed by Simpson to adapt issuing a credit card that bears partnership organizations on the card as disclosed by Feidelson. The motivation would be that co-branding a credit card by including the names of participating organizations on the card, rather than just one organization in the partnership, builds customer use in using the card by providing visual queues as to the benefit of the using the card. When a user is preparing to pay for a purchase and opens their wallet and sees, for example, three credit cards, the credit card with a visual reminder that using that card will result in a deposit into one's investment account based on the purchase value will inspire the purchaser to select that card for the purchase over a card which offers no specific and tangible reward. Building loyalty and encouraging use is the motivation behind the use of co-branded credit cards.

Neither Simpson nor Ogilvie nor Feidelson disclose where the funding of the reward feature is shared between the financial institution and the card issuer. However, Credit Card News discloses where the funding of the rewards is shared between the co-branding partners. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the reward system using a co-branded credit card as disclosed by the combination of Simpson, Ogilvie and Feidelson to adapt the reward sharing between co-branding partners as disclosed by Credit Card News. The motivation would be that each party is a partner in the co-branded product and therefore sharing the burden of rewards creates in a more economically pleasing partnership and program ownership.

Neither Simpson, Ogilvie, Feidelson nor Credit Card News specifically disclose automatically creating the investment account for the approved cardholder. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have automated creating the account because it would have sped up the process of account creation particularly given that all of the data necessary for creating the investment account manually are known to each of Simpson, Ogilvie and Feidelson, and the end result would have been the same as compared to the manual method. *In re Venner, 262 F.2d 91, 95, 1209 USPQ 193, 194 (CCPA 1958).*

Regarding claim 45, Simpson discloses allowing independent funding of the investment account by the cardholder (Figures 1 and 3; column 1, lines 54-67; column

2, lines 17-22; column 4, lines 13-19; column 4, line 63-column 5, line 5; column 5, lines 41-59).

Regarding claims 40 and 47, Simpson discloses wherein the card payment instrument account includes at least one of a credit card account, a stored value card account, a debit card account, and a multi-featured credit on a debit card account (column 1, lines 21-25 and 45-53; column 2, lines 29-49).

Regarding claims 41 and 48, Simpson discloses wherein the investment account includes at least one of a mutual fund account, a stock account, an individual retirement account, a 401(k) plan account, a savings account, a certificate of deposit account, a money market fund, and an employee stock purchase account (column 1, lines 21-25 and 45-53).

Regarding claims 42 and 49, Simpson discloses calculating the monetary reward amount each month as a percentage of net purchases in the card payment instrument account (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

Regarding claims 43 and 50, Simpson discloses transferring the monetary reward amount to the investment account at least once a year (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

Response to Arguments

Applicant's arguments with respect to claims 37, 40-45 and 47-50 have been considered but are moot in view of the new ground(s) of rejection. Newly amended claims were submitted as part of the RCE and therefore a new rejection has been set forth. However, examiner notes several points presented in the arguments as submitted with the RCE.

Applicant has argued that the references fail to disclose an investment fund card application wherein submitting and approval of the investment fund card application establishes a card payment instrument and an investment account. As detailed above, Simpson discloses where a card application and an investment fund application are submitted simultaneously and when the card application is approved, the investment fund application is then reviewed for approval and the accounts are linked. While Simpson does not disclose one application for both accounts, it would be obvious to offer one application to cover both account openings, particularly as Simpson discloses the applications are completed simultaneously and the result is a linked credit and investment account. Further, Ogilvie discloses where a single application provides for opening a credit card account, wherein a reward from credit card use be invested in a financial product and wherein designation of that investment vehicle is indicated on the credit card application. Accordingly, Ogilvie provides for a single application which enables an applicant to both apply for a credit card and to direct rewards into an investment account without having to fill out a separate form in order for the investment account deposits to occur. *In re Venner* also provides for the automating of manual

processes. As detailed in the rejection above, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have automated creating the account because it would have sped up the process of account creation particularly given that all of the data necessary for creating the investment account manually are known to each of Simpson, Ogilvie and Feidelson, and the end result would have been the same as compared to the manual method.

Applicants further argue that the prior art fails to show reward sharing between the financial institution and the credit card issuer. However, Credit Card News shows reward sharing amongst co-branding parties. As Simpson and Ogilvie both disclose that the credit card offers rewards into an investment account, and Feidelson discloses a co-branded card between a card issuer and a financial investment institution, it would be obvious that reward sharing would occur between partners wherein the partners in Simpson, Ogilvie and Feidelson are in each case a credit card issuer and a financial investment institution. Further, while Simpson does not disclose that the reward is shared between the card issuer and the financial institution, Simpson does not teach away from such a method; Simpson does not disclose that such a method would result in an incomplete or faulty method, nor does Simpson advise against it as having found it be an unsuccessful method.

Further, the Courts have stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a

technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." KSR Int'l Co. v. Teleflex, Inc. 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

In the instant case, the cited prior art references were available in the field at the time of the purported invention. The Applicant merely implemented a predictable variation of these existing methods in establishing his/her own invention. Such predicatability is based upon the fact that each incorporated method performs the same function and provides the same utility as originally intended in their pre-combination state.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692